REMARKS/ARGUMENTS

Claims 1-15 stand rejected in the outstanding non-final Official Action. Claim 10 has been cancelled without prejudice and claims 1, 14 and 15 amended. Therefore, claims 1-9 and 11-15 remain in this application.

The Examiner's indication of acceptance of the previously filed formal drawings is very much appreciated. The Examiner's consideration of the Information Disclosure Statement filed May 24, 2005 is appreciated.

However, on the copy of PTO Form 1449 received by the Applicant, the Examiner, while acknowledging receipt of JP 5-888887 (which had a translation included therewith), the Examiner marked through the indications of Japanese language documents JP 10-512069 and 10-512070. As the Examiner is most probably aware, there is no requirement for an applicant to obtain English translations of foreign language documents. However, there is an obligation for the applicant to forward prior art to the U.S. Patent and Trademark Office. There is an obligation on the part of the U.S. Patent and Trademark Office to indicate receipt of such transmitted documents, even though those documents may not have a translation attached.

Moreover, the Examiner is obligated to review the document to the extent he can understand them and indicate that he has received the documents. Consequently, Applicant encloses herewith another copy of PTO Form 1449 listing the documents submitted with the Information Disclosure Statement originally filed May 24, 2005 and respectfully requests the Examiner to acknowledge receipt and review of the two Japanese documents for which Applicant does not have English translations and confirm that to the extent understood, those documents have been considered.

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The Examiner again alleges that the title of the invention is not descriptive. The Examiner indicated in the Advisory Action mailed April 1, 2005 that the amendment filed March 15, 2005 was entered for the purpose of appeal and Applicant subsequently entered an appeal. Therefore, the Amendment filed March 15, 2005 is of record and entered in this case. That Amendment included an amendment to the title, amending the title to read "Single Instruction Multiple Data Processing Allowing the Combination of Portions of Two Data Words With a Single Instruction." This title is clearly indicative of the invention to which Applicant's claims are directed and therefore reconsideration of the requirement for a new title is respectfully requested.

While Applicant believes the current title is indicative of the claimed invention, should the Examiner have a preferred wording of a title which he believes more clearly indicates the claimed invention, Applicant will certainly consider any such proposal. Accordingly, in view of the above, the requirement for a further title revision is respectfully traversed.

Claims 14 and 15 stand objected to as allegedly failing to have antecedent basis for various terms set out in those claims. As noted in Applicant's Appeal Brief, there is no basis for a rejection based on lack of antecedent basis. (See the Appeal Brief, Section 2 entitled "The rejections based upon the alleged lack of antecedent basis"). However, Applicant has amended independent claims 1, 14 and 15 to provide literal antecedent basis for the terms, thereby obviating any further objection to claims 14 and 15.

The Examiner's acceptance that Applicant's language "a value given by" is clear on its face and the withdrawal of the previous objection to claims 14 and 15 under 35 USC §112 is very much appreciated.

Additionally, the Examiner' withdrawal of all prior rejections, both under §102 and §103, in view of the previously cited Intel reference is very much appreciated.

Claims 1-15 now stand rejected under 35 USC §103 as unpatentable over JP 5-88887 (hereinafter "JP") in view of Chan (U.S. Patent 5,276,881). Applicant has amended claims 1, 14 and 15 to limit the term "instruction" to read "a single-instruction-multiple-data instruction" (SIMD), i.e., the limitation of claim 10 has been incorporated into independent claims 1, 14 and 15.

The Court of Appeals for the Federal Circuit has consistently held that "the PTO has the burden under §103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Court went on to say that the PTO "can satisfy this burden only by showing some objective teaching in the prior art . . . ." *Id.* In other words, in order to meet its burden of establishing a *prima facie* case of obviousness for the PTO, the Examiner must be able to show that the claimed elements or method steps are clearly present in a cited prior art reference. As will be seen, the Examiner has failed to meet his burden of proof with respect to elements set out in Applicant's independent claims.

Applicant's independent apparatus claim 1, method claim 14 and computer program claim 15 all require a "single-instruction-multiple-data instruction" and, in response to that instruction, for performing an operation which "yields a value given by" the steps set out in each of those claims, i.e., selecting bit length A, selecting bit length B and combining to form portions of the output data word Rd. The Examiner contends in paragraph 21 on page 8 of the non-final Official Action that JP teaches an SIMD instruction. The Examiner does not identify any portion of Chan which contains such teaching and indeed the words single-instruction-multiple-data

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instruction or the SIMD instruction are simply missing from that reference. Moreover, there is

no indication in the JP reference which suggests that such would be understood by those of

ordinary skill in the art. Should the Examiner be of the opinion that there is any discussion of an

SIMD instruction contained in the JP reference, he is respectfully requested to specifically point

out how or why he believes this to be disclosed.

Moreover, the Examiner alleges in paragraph 12 (iii), that Applicant's instruction decoder

and its recited combining step is disclosed in the JP reference. The Examiner suggests on page

4, lines 10-12, that the decoder operates in "response to the RML instruction." Thus, the

Examiner is in effect alleging that the JP reference's RML instruction is the same as Applicant's

claimed SIMD instruction. This is simply incorrect.

The Examiner bases his conclusion upon the suggestion that the values stored in shift

registers SR1 and SR2 of the JP reference correspond to the independent data values of the

SIMD instruction. However, reference is made to paragraph 22 in the translation of the JP

reference which states "further, the shift registers SR1 and SR2 are **linked to each other** and

contents in the linked shift registers SR1 and SR2 are shifted 0 bits left." (Translation, paragraph

22, page 8, lines 7-9, emphasis added). The shifting 10 bits left is consistent with the term RML

which means "rotate multibit left" (see JP translation page 7, line 9).

Because the data words in shift registers SR1 and SR2(by the definition in the JP

reference) are "linked to each other," they clearly cannot be an SIMD instruction and this fact

would be clearly obvious to those having even nominal skill in the pertinent art. Additionally,

the use of an RML instruction (as shown in Figure 4 of the JP reference) is ill-suited to

implementation as an SIMD instruction because, if independent data words were stored in the

shift registers SR1 and SR2, the linked shift operation would result in "contamination" of the independent data values in a manner that could corrupt the calculation.

Thus, in view of the above, the Examiner is simply incorrect in his contention that the JP reference discloses an SIMD instruction, and in view of the above analysis, this would be clear to those having ordinary skill in this art.

Thus, in view of the above, the Examiner has failed to identify any use of an SIMD instruction for controlling a shifting circuit and a bit portion selecting and combining circuit. He has also failed to disclose any operation which "yields a value given by" as set out in Applicant's independent claims. Moreover, there is no allegation that the SIMD instruction is disclosed in the Chan reference and, because it is not present in the JP reference, it does not exist in either of the cited prior art references. Therefore, even if the JP reference and the Chan patent were combined, the combination would not disclose or render obvious Applicant's independent claims 1, 14 and 15 and claims dependent thereon.

Additionally, the Court of Appeals noted in the *In re Fine* case, that "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* at 1599. Additionally, this was clarified by the Court of Appeals in the case of *In re Rouffet*, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) in which the Court said:

> to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court **requires** the examiner to show a motivation to combine the references that create the case of obviousness. In other words, **the Examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (emphasis added).

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The current Official Action, other than a conclusory statement that it would be obvious to combine the references, provides no "reason" or "motivation" for combining the JP and Chan references, and therefore the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness.

Finally, the cited prior art references "teach away" from any such combination, in that if there were a motivation to implement the RML instruction of the JP reference as an SIMD instruction, this would result in "contamination" of the independent data values in a manner that could corrupt the calculation. Thus, those of ordinary skill in the art would know that one would not wish to implement an RML instruction as an SIMD instruction. Thus, the JP and Chan references teach away from Applicant's claimed combination of elements and method steps and any further rejection thereunder is respectfully traversed.

After-Final Amendment

Applicant filed a first Amendment Under Rule 116 on February 22, 2005 offering to amend claims in a specific manner. The Examiner's Advisory Action mailed March 7, 2005 denied entry of that proposed amendment, arguing that it raised new issues requiring further consideration and/or search. Applicant subsequently filed a second Amendment Under Rule 116 on March 15, 2005 making only minor corrections in the title and in the drawings. The March 15, 2005 Amendment was entered by the Examiner as noted in the Advisory Action mailed April 1, 2005 (Paper No. 20050321).

Accordingly, the February 22, 2005 Amendment was denied entry and the March 15, 2005 Amendment was granted entry. Applicant does not believe there to be any issue outstanding with respect to After-Final Amendment entry. The March 15, 2005 Amendment was
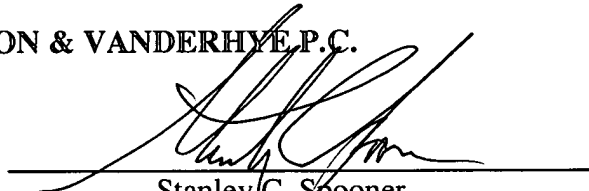
entered, which ends the discussion thereof. Applicant notes that the present amendment

accomplishes a portion of the amendment that was proposed on February 22, 2005 and denied

entry.

Having responded to all objections and rejections set forth in the outstanding Official

Action, it is submitted that remaining claims 1-9 and 11-15 are in condition for allowance and

notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a

brief telephone or personal interview will facilitate allowance of one or more of the above

claims, he is respectfully requested to contact Applicant's undersigned representative.

Respectfully submitted,

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